UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,565	10/21/1999	MEGUMI YOSHIDA	35.G2473	5702

5514 7590 07/21/2005		EXAMINER
FITZPATRICK CELLA HARPER & SCINTO		TRAN, MYLINH T
30 ROCKEFELLER PLAZA		
NEW YORK, NY 10112	ART UNIT	PAPER NUMBER
	2179	

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/422,565	YOSHIDA, MEGUMI
	Examiner	Art Unit	
	Mylinh Tran	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Amendment filed 12/07/04*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-43* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-43* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Applicant's Amendment filed 12/07/04 has been entered and carefully

considered. Claims 1, 20, 41 and 43 have been amended. However,

limitations of amended claims have not been found to be patentable over

prior art of record and newly discovered prior art, therefore, claims 1-43 are

rejected under the new ground of rejection as set forth below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in

this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-10, 20, 21, 25-29, 41 and 43 are rejected under 35

U.S.C. 102(b) as being anticipated by the Screen Dumps (Microsoft Outlook).

As to claim 1, 20, 41 and 43, Microsoft Word 2000 discloses displaying a list

including a plurality of registered character strings on a display screen (figure

2); user selecting, from the displayed list, based on a user instruction, one of

the character string included in the list displayed in said step displaying step

and storing the selected character string in a computer-readable memory

medium (figure 3);

pointing a cursor at a position on the display screen at which the selected

character string is to be inserted (figure 4);

automatically inserting the selected character string stored in the memory

medium at the position pointed by the cursor (figure 5), wherein the inserted

character string is added to image information which is to be sent to a

destination (figure 6).

As to claims 2 and 21, Microsoft Outlook also discloses the selection of the

character string being achieved by an instruction which designates a position

in a region of the display screen in which the character string to be selected

is displayed (figures 3-5).

As to claims 6 and 25, Microsoft Outlook also shows the plurality of character

strings having been registered through an operation performed by the user

(figure 2).

As to claims 7 and 26, Microsoft Outlook demonstrates the selected

character string is input to a display screen which is displayed to enable entry

of a character string to be added to image information (figures 3-5).

As to claims 8-10 and 27-29, Microsoft Outlook discloses the selected

character string being input to a display screen which is displayed to enable

entry of a character string designating a destination to which information is to

be sent (figures 5-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis

for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or
described as set forth in section 102 of this title, if the differences between the subject matter
sought to be patented and the prior art are such that the subject matter as a whole would
have been obvious at the time the invention was made to a person having ordinary skill in
the art to which said subject matter pertains. Patentability shall not be negatived by the
manner in which the invention was made.

Claims 3-5, 11-19, 22-24, 30-40 and 42 are rejected under 35 U.S.C.

103(a) as being unpatentable over Microsoft Outlook in view of An et al. [US.

5,936,614].

As to claims 3, 4, 22 and 23, Microsoft Outlook fails to clearly teach a soft

keyboard. However, An et al. shows the limitation at column 8, line 60

through column 9, line 12. It would have been obvious to one of ordinary skill

in the art,

at the time the invention was made, to combine An's teaching of the soft

keyboard with Microsoft Outlook's registered character strings. Motivation of

the combination would have been to store the character string by the soft

keyboard to save time for the users.

As to claims 5 and 24, Microsoft Outlook fails to clearly teach the list

including the registered character strings being displayed in place of the soft

keyboard display screen. However, An et al. shows the list including the

registered character strings being displayed in place of the soft keyboard

display screen, in response to said instruction (column 13, lines 11-30). It

would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Outlook's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 11 and 30, Microsoft Outlook fails to clearly teach the display of the registered character strings being displayed on an operation panel of a copying machine. However, An et al. show the feature at column 1, lines 31-53. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Outlook's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 12 and 31, Microsoft Outlook fails to clearly teach the selected character string being output by means of a printer. However, An et al. show the feature at column 14, line 60 through column 15, line 19. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Outlook's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 13, 15, 32 and 34, Microsoft Outlook fails to clearly teach instruction being given through a touch panel and the instruction being given

through a coordinate input device. However, An et al. show the features at column 16, lines 35-60. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Outlook's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 14 and 33, Microsoft Outlook fails to clearly teach instruction being given through a digitizer. However, An et al. show the features at column 6, lines 4-35. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Outlook's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claim 16, Microsoft Word 2000 discloses displaying a list including a plurality of registered character strings on a display screen (figure 2); user selecting, from the displayed list, based on a user instruction, one of the character string included in the list displayed in said step displaying step and storing the selected character string in a computer-readable memory medium (figure 3);

pointing a cursor at a position on the display screen at which the selected character string is to be inserted (figure 4);

automatically inserting the selected character string stored in the memory

medium at the position pointed by the cursor (figure 5), wherein the inserted

character string is added to image information which is to be sent to a

destination (figure 6).

Microsoft Outlook fails to clearly teach the step of character editing.

However, An et al. show the feature at column 3, lines 10-29. It would have

been obvious to one of ordinary skill in the art, at the time the invention was

made, to combine An's teaching of the soft keyboard with Microsoft Outlook's

registered character strings. Motivation of the combination would have been

to help the user having a desired character string.

As to claims 17,18, 36-37 and 39-40, Microsoft Outlook fails to clearly teach

the editorial instruction being to add or delete a character. However, An et al.

show the feature at column 2, lines 35-48. It would have been obvious to one

of ordinary skill in the art, at the time the invention was made, to combine

An's teaching of the soft keyboard with Microsoft Outlook's registered

character strings. Motivation of the combination would have been to help the

user having a desired character string.

As to claims 19 and 38, Microsoft Outlook fails to clearly teach the instruction

being input through a displayed soft keyboard. However, An et al. show the

features at column 3, lines 10-47. It would have been obvious to one of

ordinary skill in the art, at the time the invention was made, to combine An's

teaching of the soft keyboard with Microsoft Outlook's registered character

strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

As to claims 35 and 42, Microsoft Word 2000 discloses displaying a list including a plurality of registered character strings on a display screen (figure 2); user selecting, from the displayed list, based on a user instruction, one of the character string included in the list displayed in said step displaying step and storing the selected character string in a computer-readable memory medium (figure 3);

pointing a cursor at a position on the display screen at which the selected character string is to be inserted (figure 4);

automatically inserting the selected character string stored in the memory medium at the position pointed by the cursor (figure 5), wherein the inserted character string is added to image information which is to be sent to a destination (figure 6). Microsoft Outlook fails to clearly teach the inputting means for enabling input of an editorial instruction indicating an editorial work to be effected on the selected character string. However, An et al. show the feature at column 1, lines 30-60. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine An's teaching of the soft keyboard with Microsoft Outlook's registered character strings. Motivation of the combination would have been to store the character strings by the soft keyboard to save time for the users.

Response to Arguments

Applicant's arguments with respect to claims 1, 20, 41 and 43 have been

considered but are moot in view of the new ground of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications

from the examiner should be directed to Mylinh Tran. The examiner can

normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4141.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Heather Herndon, can be reached at 571-272-4136.

The fax phone numbers for the organization where this application or

proceeding is assigned are as follows:

703-872-9306

and / or:

571-273-4141 (use this FAX #, only after approval by Examiner, for

"INFORMAL" or "DRAFT" communication. Examiners may request that a

formal paper / amendment be faxed directly to them on occasions).

Information regarding the status of an application may be obtained

from the Patent Application Information Retrieval (PAIR) system. Status

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system, see http://pair-direct.uspto.gov. Should you have questions on

access to the Private PAIR system, contact the Electronic Business Center

(EBC) at 866-217-9197 (toll-free).

Mylinh Tran

Art Unit 2179

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